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REMARKS

By this Amendment, claim 10 has been added. Currently, claims 1-3, 5 and 9 are before the Examiner for consideration on their merits, with claims 4 and 6-8 withdrawn from consideration.

In review, claim 10 defines the embodiment that the intermediate section is fixed in the lenses. No new matter is introduced by this amendment, since this embodiment is clearly shown in the drawings. Claim 10 is also believed to correspond to the elected species and should be examined as part of this response.

In the action, the Examiner confirms the election of claims 1-3, 5, and 9. As detailed below, Applicants request withdrawal of the restriction requirement on the grounds that generic claim 1 is allowable.

In the prior art rejection, claims 1-3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 4,251,076 to Krupicka when taken in view of the teachings of United States Patent No. 4,965,913 to Sugarman. The rejection alleges that Krupicka teaches the invention except for the strap. The Examiner cites Sugarman to allege that it is known to use a strap to hold a pair of glasses to a user's head, and the use of such in Krupicka would be obvious.

While claim 5 is indicated as being rejected based on Krupicka and Sugarman, the Examiner also rejects claim 5 based on the combination of these two references when combined with United States Patent No. 1,660,587 to Tully. Here, the Examiner is apparently admitting that Krupicka and Sugarman do not teach the use of eye cups. Since their use is allegedly taught in Tully, the Examiner concludes that it would be obvious to use such in the strap containing golfing aid glasses of Krupicka.

Applicants respectfully traverse the rejection on the grounds that the Examiner has not established a *prima facie* case of anticipation against claim 1.

One issue in this case is whether the Examiner can ignore the fact that Applicants are claiming swimming goggles. In the rejection, the Examiner has chosen to ignore this language and considered only the claim limitations following the "comprising" term found in line 1 of claim 1.

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This stance is improper in Applicants' opinion. The issue presented here is whether the Examiner can ignore the preamble and the fact that Applicants are claiming swimming goggles, and reject claim 1 using a reference that teaches golfing aid glasses.

Applicants have not chosen to merely claim an article comprising a certain set of features. Instead, Applicants have specifically chosen to claim "swimming goggles", and by doing so, have defined a certain class of articles for which protection is sought. In essence, the Examiner has improperly chosen to ignore the Applicants' intent.

In this regard, the Examiner's attention is directed to MPEP §2111.02. The question raised above relates to the issue of what weight must the Examiner give to the claimed language of "swimming goggles." In the action, the Examiner has given this term no weight, and has alleged that since the golfing aid glasses of Krupicka allegedly contain the recited elements that the claim is anticipated. Applicants contend that the Examiner cannot ignore the fact that Applicants' invention is directed to swimming goggles in light of the mandate of the MPEP referenced above. MPEP §2111.02 states that a preamble that limits the structure of a claimed invention must be treated as a claim limitation. In the present situation, there is no doubt that a preamble that defines swimming goggle is a structural limitation that limits the structure of the claimed invention. By anyone's definition, swimming goggles are designed to keep the water from a swimmer's eyes. This inherently defines a limiting structure that must be considered by the Examiner.

The Examiner cannot ignore the fact that claim 1 is directed to swimming goggles, and the preamble of claim 1 must be considered by the Examiner when considering the question of the patentability of claim 1. Based on the assumption that the Examiner must consider the preamble of claim 1, the issue now becomes whether the golfing aid glasses of Krupicka can be considered to be structurally the same as swimming goggles in order to support a rejection under 35 U.S.C. § 102(b).

Since anticipation requires each and every element of a claim to be present in order for such a rejection to be made, it is respectively contended that Krupicka cannot establish a *prima facie* case of anticipation since this reference does not teach swimming goggles. It can be plainly seen or understood that one of skill in the art would not swim laps with the glasses of Krupicka or use the

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glasses of Krupicka to keep water from contacting a user's eyes.

Since Krupicka cannot anticipate claim 1, the rejection as applied to claim 1 must be withdrawn. Withdrawal of this rejection then leaves the Examiner with the option to rely on 35 U.S.C. § 103(a) to reject claim 1. In order to make such a rejection, the Examiner would have to contend that the motivation would exist, either expressly or implicitly, to somehow either use the glasses of Krupicka as swimming goggles or modify the glasses for swimming use. Any such contention cannot withstand an appeal since no such motivation can exist. One of skill in the art would not think that golfing aid glasses could be used as swimming goggles. Moreover, there is no reason why one would use glasses designed to sight a golf ball for swimming. Therefore, no legitimate basis exists to reject claim 1 under 35 U.S.C. § 103(a).

In light of the above, there is no basis to reject claim 1 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a), and the rejection based on Krupicka must be withdrawn.

The teachings of Sugarman or Tully do not make up for the deficiencies in Krupicka. The mere fact that a strap can be used on a pair of glasses is irrelevant to the issues identified above. Even if one were to put a strap on the glasses of Krupicka, such would not transform the glasses into swimming goggles and meet the limitations of claim 1.

Tully also does not obviate claim 1. First, it is contended that there is no motivation to add eyecups to the glasses of Krupicka. Tully teaches the use of eye cups for protection of an eye following an eye operation. This has nothing to do with golfing and one of skill in the art would not be lead to modify Krupicka with eye cups used in connection with eye surgery.

Even if one were to use the eye cups of Tully on the glasses of Krupicka, such would not transform the glasses of Krupicka into swimming goggles, and the limitations of claim 1 are still not present in the combined prior art. Moreover, the eye cups of Tully are not used for the purpose of keeping a person's eye dry during swimming and cannot be considered to be the type of cups that one would find in swimming goggles.

Claim 10 is separately patentable over the applied prior art. In Krupicka, the alleged intermediate section is moveable. Claim 10 defines an intermediate section that is fixed in the lens.

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Krupicka cannot anticipate claim 10 for the simple reason that the intermediate section 22 is not fixed in the lenses. Furthermore, there is no basis to assert obviousness since the section 22 must be moveable for the golfing aid glasses of Krupicka to function. To fix the section 22 to the lens would make the golfing aid glasses inoperable, and one of skill in the art would never be motivated to make such a change.

Finally, since claim 1 has been demonstrated above to be patentably distinguishable over the applied prior art, and it is generic to the disclosed species, Applicants are entitled to consideration of a reasonable number of species to accompany the allowance of claim 1. Since the Examiner has only identified two species in the restriction requirement, the restriction requirement should be withdrawn. More particularly, claims 4 and 6-8 directed to the non-elected species should be allowed with allowable and generic claim 1 and its species claims 2, 3, 5, 9, and 10.

To conclude, it is respectfully contended that the rejection based on 35 U.S.C. § 102(b) must be withdrawn since Krupicka does not establish a *prima facie* case of anticipation. Likewise, Krupicka cannot anticipate new claim 10. The secondary references do not supply the deficiency in Krupicka, and even if combined, the invention of claims 1 and 10 are not taught.

Accordingly, the Examiner is respectfully requested to withdraw the restriction requirement, examine this application in light of this response and pass independent and generic claim 1 and its dependent claims 2-10 onto issuance.

If for some reason, the Examiner believes that an interview with Applicants' Attorney would be helpful in expediting allowance of this application, the Examiner is invited to telephone the undersigned.

The above constitutes a complete response to all issues raised in the Office Action dated March 16, 2006.

Again, reconsideration and allowance of this application is respectfully requested.

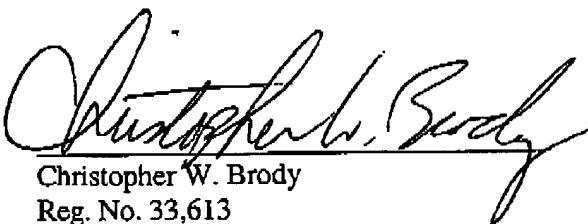
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Respectfully submitted,

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Docket No.: 12010-0056
Date: May 1, 2006